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Group Art Unit: 1617
Applicants' Response to Paper No. 8

REMARKS

Claims 11-30 are currently pending in the present application.

Election Requirement

In Paper No. 8, the Examiner has required the election of a single invention for examination and prosecution on the merits. More specifically, the Examiner has required that "applicants must elect one ultimate mixture for examination." (*See*, Paper No. 8, p. 2). The Examiner contends that the application contains claims directed to "plural compositions comprising a mixture of two or more different compounds." (*See, id.*). The Examiner also contends that "[e]ach mixture constitutes a unique special technical feature because each compound possesses unique properties based on its structure." (*See, id.*). The Examiner has also noted that "[t]he compounds are specified as a1, a2, a3 and a4 in claim 1." (*See, id.*). Finally, the Examiner also requires that "[i]f applicants elect a3 as one of the components of the mixture one ultimate a3 must be elected from claim 22." (*See, id.*).

On the basis of the foregoing arguments and contentions, the Examiner has required the election of a "single mixture".

Traversal of the Restriction Requirement

Applicants strenuously, but respectfully, traverse the election requirement for the following reasons.

To begin with, section 1893.03(d) of the M.P.E.P., 7th Edition, Revision 1, clearly explains 37 C.F.R. §1.499, which governs Unity of Invention during the national stage, as follows: "[w]hen making a lack of unity of invention requirement, the examiner must (1) list the different groups of *claims* and (2) explain why each group lacks unity with each other group (*i.e.*, why there is no single general inventive concept) specifically describing the unique special technical feature in each group." (*See*, M.P.E.P. §1893.03(d), (*emphasis added*)).

The Examiner has not identified any groups of claims. Moreover, the Examiner has not explained how any one group of claims lacks unity with another group of claims. The

Examiner has simply argued that "each compound possesses unique properties based on its structure." The Examiner then concludes based upon this argument, that each mixture constitutes a unique special technical feature. The Examiner's arguments and conclusion are flawed in many respects and are incorrect with respect to a determination of unity of invention.

One embodiment of Applicants' claimed invention is directed to cosmetic preparations comprising:

(a) a mixture of two or more surfactants selected from the group consisting of (a1) fatty acid (polyglycol) esters, and (a2) fatty alcohol (polyglycol) ethers, and at least one component selected from the group consisting of (a3) polyols and (a4) alk(en)yl oligoglycosides, the mixture present in an amount of from 30 to 70% by weight; and

(b) one or more oil components in an amount of from 70 to 30% by weight; said percentages by weight based upon a total weight of the mixture and the one or more oil components.

Thus, in each claimed cosmetic preparation, a mixture of two or more surfactants selected from (a1) fatty acid (polyglycol) esters and (a2) fatty alcohol (polyglycol) ethers is present along with at least one component selected from (a3) polyols and (a4) alk(en)yl oligoglycosides. This special technical feature which all of the present claims have in common, –at least two selected from (a1) and (a2) along with at least one selected from (a3) and (a4)–, unites all of the alleged separate inventions claimed in the instant application.

The law requires the Examiner to identify groups of claims and explain why each group lacks unity of invention with the others. The Examiner has NOT identified any separate groups of claims. In fact, it appears that the Examiner has treated all of the claims as one group. Independent claim 11 and each of those claims dependent therefrom, *i.e.*, claims 12-28, as well as independent claims 29 and 30, each recite at least two surfactants selected from (a1) and (a2) along with at least one component selected from (a3) and (a4). Accordingly, it is difficult, if not impossible, to determine which claims the Examiner has grouped separately from any other group of claims.

Even if one were able to determine how the Examiner has decided to group the claims, the Examiner has absolutely failed to provide any explanation as to why any one group of claims lacks unity with another group of claims. No groups have been identified. The Examiner has argued that "each mixture constitutes a unique special technical feature because each compound possesses unique properties." This argument is deficient as a matter of law. The inventive mixtures must be considered as a whole, not on the basis of different individual components.

The various divergent properties of different compounds contained in an inventive mixture do not create various special technical features. Under the law, the term "special technical feature" has a specific meaning. Pursuant to PCT Rule 13.2, the Examiner must consider each invention as a whole with respect to "special technical features". PCT Rule 13.2 states that,

> [w]here a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, *considered as a whole*, makes over the prior art. (Patent Cooperation Treaty, Rule 13.2 (*emphasis added*)).

Thus, Applicants submit that it is the technical feature which all of the claims have in common, *i.e.*, the "at least two selected from (a1) and (a2) along with at least one selected from (a3) and (a4)", that unites all of the claimed inventions. Accordingly, Applicants respectfully submit that all of the pending claims relate to a single general inventive concept under PCT Rule 13.1, namely the cosmetic preparations containing the claimed amount of oil component and the claimed amount of the mixture of at least two selected from (a1) and (a2) along with at least one selected from (a3) and (a4). Moreover, PCT Rule 13.4 specifically allows multiple dependent claims to particular embodiments which could be considered to be a separate invention.

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Finally, Applicants respectfully note that the PCT authorized officer who handled the instant application during the international stage did not have an objection based upon unity of invention.

Therefore, Applicants respectfully submit that the election requirement of a single disclosed invention for prosecution on the merits is improper, and further request reconsideration by the Examiner, withdrawal of the election requirement, and concurrent prosecution on the merits of all pending claims and subject matter embodied therein.

Provisional Election With Traverse

In the event the Examiner does not find Applicants' arguments with respect to the withdrawal of the election requirement persuasive, and the Examiner maintains the election requirement set forth in Paper No. 8, Applicants provisionally elect a cosmetic composition comprising: (a) a mixture of at least one fatty acid (polyglycol) ester, at least one fatty alcohol (polyglycol) ether, and at least one alkylene glycol, the mixture present in an amount of from 30 to 70% by weight; and (b) one or more oil components in an amount of from 70 to 30% by weight; said percentages by weight based upon a total weight of the mixture and the one or more oil components, with traverse, for prosecution on the merits.

Respectfully submitted,

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(Date)

By: _____

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